UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte LINDELL C. RICHEY, ALBERT H. CHAPDELAINE, PHILLIP G. SCHNELL, TOMAS M. MINDAK and CHRISTAFOR E. SUNDSTROM

Appeal No. 2005-1581
Application No. 09/681,692

ON BRIEF

Before PAK, JEFFREY T. SMITH and FRANKLIN, Administrative Patent Judges.

JEFFREY T. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 36 all of the pending claims. We have jurisdiction under 35 U.S.C. § 134.

OPINION

Appellants' invention relates to coated chewing gum products and methods of making same. (Specification, page 1, lines 7-9). According to Appellants, the products of the invention are designed to provide improved flavor perception as compared to similar type products. (Brief, p. 3). Representative claims 1 and 21 are reproduced below:

> 1. A coated chewing gum product comprising:
> a gum center that includes a water soluble portion and a water insoluble portion, the water insoluble portion comprising at least 50% by weight of the gum center, the gum center including less than 5% by weight of bulk sweeteners; and
> a coating that at least substantially surrounds the gum center
>
> 21. A coated chewing gum product comprising:
> a gum center that includes a water insoluble portion, the water insoluble portion comprising at least 50% by weight of the gum center, the gum center including less than 5% by weight of bulk sweeteners; and
> a coating that at least substantially surrounds the gum center.

As evidence of unpatentability, the Examiner relies on the following references:

McGrew et al. (McGrew)	5,336,509	Aug. 9, 1994
Yatka	5,536,511	Jul. 16, 1996

The Examiner rejected claims 1-36 under 35 U.S.C. § 103(a) as unpatentable over McGrew in view of Yatka.[1]

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellants in

1 The Examiner's reasons for rejecting the claims appear in the Office Action mailed April 09, 2004.

support of their respective positions. This review has led us to conclude that the Examiner's rejection is well founded. Our reasons follow.

OPINION

The Examiner asserts that McGrew "discloses a wax-free, low calorie chewing gum pellet (column 16, line 52) including at least 70% wax-free gum base and no bulk sweetener (column 15, lines 10-12). Also present are 2-7% flavoring agent and an emulsifier. It would have been obvious to coat the chewing gum in McGrew et al with a syrup coating including 1% flavoring agent, 0.3% artificial sweetener and 1% dispersing agent, wherein the coating is at least 50% of the product, since it is well known to coat chewing gum with such a composition, as evidenced by Yatka et al (column 6, line 42 to column 7, line 54). The coating in Yatka et al is applied using a panning procedure." (Office Action mailed April 09, 2004).

Appellants argue that there is no suggestion, teaching or motivation to combine McGrew with Yatka and that McGrew teaches away from a combination with Yatka. (Brief, pp. 7-8, and 10-11). Appellants also argue that the Examiner reached the present invention only through the use of hindsight reconstruction. (Brief, p. 9).

These arguments are not persuasive. McGrew discloses that it had been recognized by persons skilled in the art to reduce or eliminate the caloric bulking agent to produce low caloric chewing gums. (Col. 2, ll. 5-11). Moreover, McGrew discloses an embodiment where the chewing gum composition excludes or substantially eliminates the bulking agent. (Col. 15, ll. 10-13). McGrew discloses the

chewing gum composition can take the form of pellets. (Col. 16, ll. 48-51). Yatka discloses a coating for pellet chewing gum which is useful in producing sugarless products. (Col. 3, ll. 12-14). Yatka teaches at column 1, lines 21-25 that: "Chewing gums, including pellet chewing gums, are frequently enclosed with hard or soft coatings. Coatings provide an opportunity for the manufacturer to vary product characteristics such as taste, appearance and nutritional value." Yatka discloses the hard coating that comprises erythritol provides a desirable cooling effect and crunchiness and is an improvement over the use of xylitol for hard coating of sugarless chewing gum products because of its lower cost. Further Yatka discloses that hard shell coatings made with erythritol are smoother than comparable xylitol coatings. (Col. 3, ll. 16-20). Thus, a person of ordinary skill in the art would have been motivated to coat the sugarless chewing gum product of McGrew with the sugarless coating disclosed by Yatka to obtain the advantages associated with the coating.

We do not agree that Yatka teaches away from using the chewing gum pellet composition of McGrew. Yatka provides a discussion of components that are commonly used in chewing gum formulations. A person of ordinary skill in the art would have utilized the formulation discloses by McGrew in order to obtain a coated pellet chewing gum product that would have had the cumulative advantages disclosed by both McGrew and Yatka. Moreover, there is no disclosure in Yatka that states the gum base must include a wax component. A person of ordinary skill in the

art would have reasonably expected that the pellet chewing gum of McGrew could have been coated with a coating such as the one disclosed by Yatka. "For obviousness under § 103, all that is required is a reasonable expectation of success." *In re O'Farrell*, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

"Once a *prima facie* case of obviousness has been established, the burden shifts to the applicant to come forward with evidence of nonobviousness to overcome the *prima facie* case." *In re Huang*, 100 F.3d 135, 139, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996).

Appellants allege that the present invention provides unexpected results. Specifically, Appellants state:

> Experimental studies demonstrate the unexpected results from using a high level of base and little or no bulk sweetener in a coated chewing gum formulation, especially in miniaturized coated gum products. For example, on pages 8-10 of the instant patent application, experimental gum and coating compositions are discussed. Example 2 represents one of the gum center compositions and is combined with one of the coating compositions to form a miniature coated gumball. The resulting gum product is an example of a gum composition having a gum center that includes a water insoluble portion comprising at least 50% by weight of the gum center and less than 5% by weight bulk sweeteners. Specifically, the gum center composition of Example 2 includes a gum base comprising 64.9% by weight of the gum center and no bulk sweetener. In blind taste testing of four gumballs, 56% of the participating subjects rated the gum product as more breath freshening and 45% of the participating subjects rated the gum product as having a longer lasting flavor as compared to other commercially available coated chewing gum products. If the participating subjects were allowed to take in more gumballs while chewing the initial four pieces, the breath freshening characteristics and the perception of having a longer lasting flavor increased to 59% and 47%, respectively[.]
> (Brief, pp. 12-13).

Having reviewed the data in the specification[2], we determine that the showing in the specification is not commensurate in scope with the degree of protection sought by the claimed subject matter. See *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); *In re Tiffin*, 448 F.2d 791, 792, 171 USPQ 294, 294 (CCPA 1971). It is well settled that "[O]bjective evidence of nonobviousness must be commensurate in scope with the claims.") (quoting *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979) ("The evidence presented to rebut a *prima facie* case of obviousness must be commensurate in scope with the claims to which it pertains."). In the present case, the claimed subject matter encompasses a chewing gum product that comprises a gum center that includes a water insoluble portion that comprising at least 50% by weight of the gum center and the gum center including less than 5% by weight of bulk sweeteners. However, the alleged unexpected results are obtained by using a single gumball composition produced from the formulation of Examples 2 and 6. (Specification, p. 11). Appellants have not explained why this showing is commensurate in scope with the claimed subject matter. In other words, Appellants have not directed us to evidence that establishes why this single formulation presented in the specification would have been representative of the scope of the claimed invention. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980).

[2] Specification pages 9-11.

Moreover, Appellants have also not explained why the results achieved in the specification would have been unexpected by one of ordinary skill in the art, see *In re Freeman*, 474 F.2d 1318, 1324, 177 USPQ 139, 143 (CCPA 1973); *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972).

Based on our consideration of the totality of the record before us, having evaluated the *prima facie* case of obviousness in view of Appellants' arguments and evidence, we conclude that the subject matter of claims 1-36 would have been obvious to a person of ordinary skill in the art from the teachings of the McGrew and Yatka references. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

CONCLUSION

For the foregoing reasons and those set forth in the Answer, based on the totality of the record, we determine that the preponderance of evidence weighs in favor of obviousness, giving due weight to Appellants' arguments and evidence. Accordingly, the Examiner's rejection under 35 U.S.C. § 103 is affirmed.

TIME FOR TAKING ACTION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(iv).

Affirmed

CHUNG K. PAK
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

BEVERLY A. FRANKLIN
Administrative Patent Judge

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